

REMARKS

Applicants have carefully reviewed this Application in light of the Final Office Action mailed September 3, 2008. Claims 2-11 and 13-20 are pending and Claims 2-11 and 13-20 stand rejected by the Examiner under 35 U.S.C. § 103(a). Claims 1 and 12 were previously cancelled without prejudice or disclaimer. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 103

Claims 2-7, 10-11, 13-14, 16 and 19-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,285,656 issued to Srinivas Chaganty et al. (“*Chaganty*”) in view of U.S. Patent No 6,639,895 issued to Michael A. Helles et al. (“*Helles*”).

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chaganty* in view of *Helles* as applied to claim 7 above, and further in view of U.S. Patent No. 6,381,218 issued to Michael S. McIntyre et al. (“*McIntyre*”).

Claims 9, 15 and 17-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Chaganty* in view of *Helles* as applied to claims 7, 13 and 16 above, and further in view of U.S. Patent No. 6,032,194 issued to Silvano Gai et al. (“*Gai*”).

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int’l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog*

Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc., 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Claims 3, 7 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,882,653 issued to Yoshinao Kiuchi et al. (“*Kiuchi*”) in view of U.S. Patent Application Publication No. 2002/0176355 by Alan Mimms (“*Mimms*”).

Chaganty discloses a network flow switch system that uses an active flow switch and a passive flow switch in conjunction to achieve redundancy or failover. (Abstract). The active and passive switches are connected to each other via failover links. (Col. 2, Lines 39-42). Status signals are transmitted between the switches across the failover links. (Col. 4, Lines 1-2). When the passive switch detects a failure of the active switch, the passive switch becomes active. (Col. 3, Lines 8-11).

Helles discloses a fault tolerant network switch including two or more switches in which one switch may take over in the event of failure of the other. (Abstract).

Claim 3 recites a system “wherein [a] status circuit communicates link status of [a] switch-side port to [a] fail-over circuit” and “wherein [a] fail-over circuit [of a switch] automatically disables [a] server-side port [of the switch], in response to receiving a link status of down from [a] status circuit [of the switch].”

Claim 7 recites an apparatus “wherein the status circuit communicates link status of the switch-side port to the fail-over circuit” and “wherein [a] fail-over circuit [of a switch] automatically disables [a] server-side port [of the switch]..., in response to receiving a link status of down for [a] switch-side port [of the switch] from [a] status circuit [of the switch].”

Claim 13 recites a method comprising “monitoring link status of a switch-side port of a switch” “in response to detecting a link status of down on [a] switch-side port [of the switch], automatically disabling [a] server-side port of the switch.”

Applicants respectfully submit that *Chaganty* and *Helles*, either alone or in combination, fail to disclose each and every element of the Applicants’ invention. For example, *Chaganty* and *Helles* fail to teach, disclose, or suggest communicating or monitoring a “link status of [a] switch-side port” and a system, apparatus or method “wherein [a] fail-over circuit [of a switch] automatically disables [a] server-side port [of the switch], in response to receiving a link status of down from [a] status circuit [of the switch].”

The Examiner argues that the limitation of communicating or monitoring a “link status of [a] switch-side port” as recited in Claims 3, 7, and 13 are disclosed by *Chaganty* as follows:

Chaganty further discloses *a status circuit in the first switch in communicating link status of the switch-side port to a fail-over circuit* (Col. 8 lines 38-39 Flow switch continues to monitor status signals and status signal requests where the status circuit and fail-over circuit are part of the switch).

(Office Action, Pages 3, 6, 7).

The portion of *Chaganty* cited by the Examiner merely states “Flow switch 105 continues to monitor status signals and status signal requests.” (Col. 8, lines 38-39). However, as argued by the Applicants in their many of their previous responses, neither this portion of *Chaganty* nor any other part of *Chaganty* contemplates that the monitored status signals relate to a “link status of [a] switch-side port” as recited in Claims 3, 7, and 13. Instead, *Chaganty* contemplates the monitoring of status signals across a failover link connecting active and passive switches. (Col. 3, Lines 8-11; Col. 4, Lines 1-2). The cited reference does not teach any fail-over system or method in which the switch-side ports, to which Y-cables 145 and 150 are attached leading to routers 175 and 180, are monitored. (Col. 2, Lines 61-65. *See also* Fig. 1). Accordingly, the monitoring of status signals on the failover link as contemplated in *Chaganty* is distinct from the communication and monitoring of link status of the switch-side port recited in Claims 3, 7 and 13.

The Examiner’s rejection also fails because *Chaganty* fails to disclose the monitoring of a link status of a switch-side port as inherent or necessarily present. To establish that a claim element is inherent in a prior art reference, extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999); M.P.E.P. § 2112(IV). Inherency, however, may not be established by probabilities or possibilities. *Id.* In the present case, it appears as if the Examiner has assumed that a status message relating to a switch failure in *Chaganty* might possibly include information regarding the link status of the switch’s switch-side port. Despite repeated objections by the Applicants, the Examiner has continually failed to point out the portions of *Chaganty* or the evidence currently entered of record in the current application in which it is contemplated that a status message relating to a switch failure may necessarily include

information regarding the link status of the switch's switch-side port. If the Examiner is relying upon personal knowledge, no affidavit has been provided. *See* M.P.E.P § 2144.03 (setting forth the requirements of reliance of common knowledge in the art).

In the most recent Office Action, the Examiner does not provide any response or commentary to the arguments above. Nonetheless, the Applicants reiterate such arguments.

The Examiner also alleges that *Helles* discloses “a switch disabling a port based on receiving a link status of down from a status circuit on the switch and monitoring a port,” relying on Fig. 2 and Columns 4 and 5 of *Helles*. (Office Action, Pages 4, 6, 7). The Examiner claims that these portions of *Helles* disclose “where the fault detector detects a failure of a port and causes the network switch to cease function and signals to another switching unit of the failure”. (*See, e.g.*, Office Action, Page 4). The sole reference to a fault detector in the cited portion of *Helles* reads:

Network switch unit SU1 also includes a fault detector 70 connected each of the switching controller 50, a power supply, a fan, and other components of the network switch unit SU1 the failure of which could cause the network switch unit to cease functioning, so that it is responsive to a fault in any of the components of the network switch unit SU1 to generate a fault signal and can communicate the fault signal to another network switch unit, or use it internally. The fault detector 70 is implemented through a combination of software and hardware. A manual mechanism may be provided per network switch unit to simulate a failure for maintenance purposes.

(Col. 4, lines 23-35).

It appears as if the Examiner relies on a vague statement of the operation of a prior art reference to reject a specifically recited element of Applicants' claims. Nowhere in the cited passage is there mentioned a server-side port or a link status of down, let alone a “fail-over circuit automatically disabl[ing] the server-side port, in response to receiving a link status of down from the status circuit” as recited in Claims 3, 7 and 13.

In the most recent Office Action, the Examiner responds to these arguments regarding *Helles* as follows:

Helles does disclose a switch disabling a port based on receiving a link status of down from a status circuit on the switch (Col. 4 lines 23-31 a fault detector detects a fault of components of the switch and generates and communicates a fault signal to another switch unit or uses it internally and Col. 5 lines 54-57 When a failure occurs, the failed network switch unit is removed and replaced. During the failure, the other network switch unit services the network connections formerly services by the failed network switch unit). The port is

disabled once it fails after a fault signal is generated. Helles further discloses monitoring a port (Col. 4 lines 23-31 a fault detector detects a fault of components of the switch). A port is a component of the switch, so therefore it is monitored by the fault detector.

(Office Action, Page 16).

Whether or not the Examiner has correctly characterized *Helles*, Applicants are at a loss to determine how the above response by the Examiner is at all relevant to the claimed subject matter. Nothing in *Helles* discloses a link status of a switch-side port, let alone any action taken in response to a link status. The Examiner has yet to make it clear what portion or component of *Helles* that the Examiner has equated to a link status in making the rejections.

For at least these reasons, *Chaganty* and *Helles*, either alone or in combination, fail to disclose the recited limitations and, therefore, cannot anticipate Claims 3, 7, and 13. Given that Claims 2 and 4-6 depend from Claim 3, Claims 8-11 depend from Claim 7, and Claims 14-20 depend from Claim 13, Applicants respectfully submit that Claims 2, 4-6, 8-11 and 14-20 are allowable. As such, Applicants respectfully request that the Examiner withdraw the rejections and allow Claims 2-11 and 13-20.

In addition, the Examiner makes the conclusory statement that “It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Chananty to include a switch disabling a port based on receiving a link status of down from a status circuit on the switch as taught by Helles in order to quickly recover from a failure and prevent data loss of delay.” The Applicant notes that no evidence in the prior art of record, or any other evidence or record supports the proposition that this reason alone is sufficient reason to combine the references.

The Examiner’s statements are not sufficient to support a finding of obviousness because “[t]he key to supporting any rejection under 35 U.S.C. [§] 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*” M.P.E.P. § 2143 (emphasis added). The M.P.E.P. also states that “the analysis supporting a rejection under 35 U.S.C. [§] 103 should be *made explicit.* *Id.* (emphasis added). M.P.E.P. § 2143 also sets forth a host of exemplary rationales and Examiner may employ in maintaining a rejection, including particular findings of fact required to support each such rationale. In the present case, the Examiner has not made any such rationale explicit, has not supported the

rejection using any rationale set forth in M.P.E.P. § 2143 or other suitable rationale, and has not made any factual findings to support any such rationale. For example, if the Examiner maintains rejections on a rationale the some teaching, suggestion or motivation in the prior art would have led one of ordinary skill in the art to modify and/or combine prior art references, the Examiner must make and articulate each of the following findings:

- a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of skill in the art, to modify the reference or to combine reference teachings;
- a finding that there was reasonable expectation of success; and
- whatever additional findings based on the factual inquiries under *Graham v. John Deere Co.*, 383 U.S. 1 (1966) as may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

As another example, if the Examiner's rationale is that combining the allegedly prior art elements according to known method yields predicable results, to support a rejection on such a rationale, the M.P.E.P. states that the Examiner must articulate, *inter alia*:

- a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately; and
- a finding that one of ordinary skill in art would have recognized that the results of the combination were predictable.

The Examiner has failed to assert any of these rationales or make any of these necessary findings, perhaps because there is no documentary evidence of record in the present application to make such a finding. The Examiner is respectfully reminded that any findings must be supported by documentary evidence in the record. 37 C.F.R. § 1.104(c)(2); M.P.E.P. § 2144.03(C). The Examiner is also respectfully reminded that if the Examiner relies on personal knowledge to support a finding of what is known in the art, such finding must be supported with an affidavit or declaration setting forth specific factual statements and explanation to support the finding. 37 C.F.R. § 1.104(d)(2); M.P.E.P. § 2144.03(C). In light of the Examiner's failure to establish a *prima facie* case and provide necessary documentary evidence of obviousness, Applicant submits that Claims 2-11 and 13-20 may not be rendered obvious.

CONCLUSION

Applicants appreciate the Examiner's careful review of the application. Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. For the foregoing reasons, Applicants respectfully request reconsideration and full allowance of Claims 2-11 and 13-20.

Applicants believe there are no further fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2684.

Respectfully submitted,
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